

REMARKS

Pursuant to the present amendment, claims 27, 30, 31, 41, 42, 48, 49, 50 and 52-54 have been amended and new claims 55-67 have been added. Thus, claims 27-67 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested in view of the amendments and arguments set forth herein.

In the Office Action, claims 27-32, 37-43 and 49-52 were rejected under 35 U.S. § 103 as allegedly being unpatentable over Cunningham (U.S. Patent No. 5,819,852). Claims 33, 35, 36, 53 and 54 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Cunningham in view of Robertson (U.S. Patent No. 6,360,822). Claim 34 was rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Cunningham and Robertson in view of Cowan (GB Patent No. 2,233,365). Claims 44, 45, 47 and 48 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Cunningham in view of Doremus (U.S. Patent No. 4,658,904). Claim 46 was rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Cunningham in view of Coutts (WO 93/03254). Applicant respectfully traverses the Examiner's rejections.

As the Examiner well knows, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. With respect to alleged obviousness, it is necessary for the Examiner to

identify the reason why a person of ordinary skill in the art would have combined the prior art in the manner claimed. The mere fact that the prior art can be combined or modified does not make the resultant combination obvious. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Device Claims

Pursuant to the present amendment, the independent device claims – claims 27, 52, 53 and 54 – have been amended to recite that the tool housing assembly is adapted to receive a tool therein, the tool being operatively coupled to a wire, a cable or a line, and that the sealing assembly is adapted to slidingly seal around the wire, cable or line. All of these device claims stand rejected as being obvious in view of Cunningham. Applicant respectfully submits that the presently amended claims are allowable over the art of record.

Fundamentally, Cunningham is not directed to a subsea lubricator. That is why Cunningham never refers to the device disclosed therein as a lubricator – as noted by the Examiner several times – because it is not one. Rather, Cunningham is directed to a “completion/intervention riser system.” Col. 4, ll. 40-41. The system in Cunningham comprises a branch-off section 20, an emergency disconnect package 22 and a riser safety package 24. Col. 4, ll. 58-64. The branch-off section 20 includes a production bore 52 that is in direct communication with the bore 48 in the riser 18, and an annulus bore 54 which branches off of the production bore 52. A bore selector 56 is provided for selectively closing either the production bore 52 or the annulus bore 54. A retainer valve 58 is provided for selectively sealing off the riser bore 52 above the bore selector 56. Col. 5, ll. 40-47.

As thus amended, it is respectfully that independent claims 27, 52, 53 and 54 are allowable over the art of record. At no point does Cunningham even remotely suggest a lubricator comprised of a sealing assembly that is adapted to slidingly seal around a wire, cable or line that is operatively coupled to a tool.

The Examiner identified the retainer valve 58 in Cunningham as the “sealing assembly.” Final Office Action, p. 2. The Examiner then stated, in mere conclusory fashion, that the retainer valve 58 could be adapted to seal around the tool lowering means. Applicant respectfully submits that the Examiner’s conclusory statements regarding what “could be” done are improper in the context of an obviousness analysis. The question is whether there is any logical reason why one skilled in the art would have been motivated to modify the teachings of Cunningham as suggested by the Examiner. Applicant respectfully submits that the Examiner has not identified any such reason. Accordingly, the Examiner’s obviousness rejection is legally improper.

The retainer valve 58 disclosed in Cunningham is employed to seal off the bore above the bore selector 56. Col. 5, ll. 40-47. At no point is it even remotely suggested that the retainer valve 56 is adapted to slidingly seal around a wire, cable or line used in lowering a tool into the branch-off section 20 shown in Cunningham. This is further evidence that, as stated before, Cunningham is not a lubricator device at all, as that term is used and understood by those skilled in the art.

Moreover, there does not appear to be any logical reason why one would attempt to modify the teachings of Cunningham so as to arrive at Applicant’s invention, as defined by amended claims 27, 52, 53 and 54. The retainer valve 58 in Cunningham is used to seal off the bore above the bore selector 56. That is why the valve 58 in Cunningham is called a retainer

valve – it retains fluids on one side of the valve. The claimed sealing assembly is adapted to slidingly seal around a wire, cable or line extending through the sealing assembly. Thus, it is not clear to the undersigned why one skilled in the art would be motivated to apply a sealing assembly like that claimed to attempt to seal off the bore above the bore locator 56 in Cunningham, if that is even possible. The Federal Circuit has made it crystal clear that conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1434 (Fed. Cir. 2002). It is respectfully submitted that any attempt to assert that the inventions defined by the presently pending claims would have been obvious in view of the prior art of record constitutes an impermissible use of hindsight using Applicant's disclosure as a roadmap.

New claims 55-63 have been added to further define Applicant's invention. New independent claim 55 is broader than any of the pending independent device claims. However, new claim 55 is believed to be allowable for the reasons set forth above with respect to the other device claims.

Dependent claim 56 further limits claim 55 by reciting that the tool housing comprises a single passageway that is adapted to receive the tool. Certainly, claim 56 is allowable over the art of record. In Cunningham, the Examiner's primary reference, it is not understood how the device disclosed therein could even operate for its intended purposes if it only had a single passageway that was adapted to receive a tool, instead of the two bores 52 and 54 disclosed therein. Thus, it is not clear that the device in Cunningham could be modified to contain all the claim limitations set forth in dependent claim 56.

Similarly, with respect to claim 57, the branch-off section 20 in Cunningham is not a “tubular column” as recited in claim 57. Moreover, there is no suggestion that the branch-off section 20 in Cunningham could even work for its intended purpose if the branch-off section 20 was a “tubular column” as set forth in claim 57.

With respect to claims 58 and 59, there is simply no suggestion that the device disclosed in Cunningham would work at all if the retainer valve 58 were replaced with a grease injector head or a stuffing box as set forth in these claims, respectively. It does not appear that such a grease injector head or stuffing box, as those terms are normally understood, could be employed to seal off the riser bore – the intended purpose of the retainer valve 58 in Cunningham.

New dependent claims 63-67 have been added to make it clear that the present lubricator is a riserless subsea lubricator. It is believed that this is evident from the fact that it is recited as being attached above a subsea Christmas tree. Nevertheless, claims 63-67 make it expressly clear that the present invention is directed to riserless subsea lubricators. Clearly, the device disclosed in Cunningham is employed with subsea risers.

For the aforementioned reasons, it is believed that all pending device claims, *e.g.*, claims 27-41 and 52-67 are in condition for immediate allowance.

One other point worth noting is the Examiner’s statement regarding official notice. First, it is incumbent upon the Examiner to produce evidence that supports the rejections made in the Office Action. The Examiner cannot shift the burden to the Applicant by making unsupported allegations – even if used with the slogan “official notice” – to disprove the merits of such unsupported allegations. Thus, Applicant has not and does not acquiesce to any statements made by the Examiner regarding “official notice.” As always, the burden remains on the Examiner to

come forward with evidence – not allegations – to support the rejections made in the Office Action.

Method Claims

1. Claim 42

Pursuant to the present amendment, claim 42 has been amended to clarify the structure of the subsea lubricator set forth in the claims. As set forth above, Cunningham does not disclose a subsea lubricator. Thus, by definition, it does not disclose the various method steps recited in claim 42 in connection with the subsea lubricator set forth in the amended claim. Accordingly, for at least this reason, claim 42 is allowable over the art of record.

Additionally, claim 42 is directed to a method for circulating fluid in a subsea lubricator attached to a subsea Christmas tree landed on a subsea well that includes, among other steps, circulating the first internal fluid to the subsea well through the bypass passage and the subsea Christmas tree or into an external flow line. In rejecting claim 42, the Examiner stated that Cunningham discloses the step of “circulating the first internal fluid to the subsea well through the bypass passage and the subsea Christmas tree.” Final Office Action, p. 6, citing Col. 6, ll. 23-25. Applicant respectfully disagrees.

The portion of Cunningham referenced by the Examiner is directed to the situation where it is desired to disconnect the riser system 10 from the Christmas tree 14. Col. 6, ll. 14-15. To accomplish that task, coiled tubing 50 is employed to circulate fluid out of the monobore riser conduit 18. Col. 6, ll. 16-19. During this operation, the crossover valve 74, annulus isolation valve 76 and blind ram 80 are all closed. Col. 6, ll. 18-19. According to Cunningham, “circulation fluid, such as sea water, is then pumped down tubing 50 and is directed back up the

annulus between the bore 48 and the tubing 50 by blind ram 80 to thereby clear monobore riser 18 of production fluid.” Col. 6, ll. 22-25 (emphasis added). Simply put, in Cunningham, the circulation fluid is pumped down coiled tubing 50 and up the annulus between the bore 48 and the coil tubing 50 and thus back to the surface. Cunningham does not disclose or suggest that this circulating fluid or the original production fluid in the riser 18 is circulated to the well at all. Moreover, in the method identified by the Examiner in Cunningham, the bypass line 82 disclosed therein is not employed at all. Since the valves 74, 76 and blind ram 80 are all closed, as referred to in lines 19-20, there is no access to the Christmas tree and the fluid in Cunningham cannot be injected to the well. Therefore, for at least these reasons, it is respectfully submitted that Cunningham does not disclose the method recited in claim 42.

2. Claim 49

Pursuant to the present amendment, claim 49 has been amended to clarify the structure of the subsea lubricator set forth in the claims. As set forth above, Cunningham does not disclose a subsea lubricator. Thus, by definition, it does not disclose the various method steps recited in claim 49 in connection with the subsea lubricator set forth in the amended claim. Accordingly, for at least this reason, claim 49 is allowable over the art of record.

Additionally, claim 49 recites a method for killing a subsea well having a subsea Christmas tree landed thereon including the steps of landing a subsea lubricator on the subsea Christmas tree, the subsea lubricator comprising at least one valve, providing at least one bypass passage fluidly connecting the subsea Christmas tree with a source of kill fluid, and when the at least one valve is closed, injecting the fluid into the well through the bypass passage and the subsea Christmas tree.

In rejecting claim 49, the Examiner relied upon the same passage (Col. 6, ll. 22-25) cited above in rejecting claim 42. As set forth above, the portion of Cunningham referenced by the Examiner is directed to the situation where “circulation fluid, such as sea water, is then pumped down tubing 50 and is directed back up the annulus between the bore 48 and the tubing 50 by blind ram 80 to thereby clear membrane riser 18 of production fluid.” Col. 6, ll. 22-25 (emphasis added). Simply put, in Cunningham, the circulation fluid is pumped down coiled tubing 50 and up the annulus between the bore 48 and the coil tubing 50 and thus back to the surface. In the method identified by the Examiner in Cunningham, the bypass line 82 disclosed therein is not employed at all. Since the valves 74, 76 and blind ram 80 are all closed, as referred to in lines 19-20, there is no access to the Christmas tree and the fluid cannot be injected to the well. Thus, Cunningham does not disclose injecting a kill fluid into the well through the bypass passage as recited in claim 49. Therefore, for at least these reasons, it is respectfully submitted that Cunningham does not disclose the method recited in claim 49.

3. Claim 50

Pursuant to the present amendment, claim 50 has been amended to clarify the structure of the subsea lubricator set forth in the claims. As set forth above, Cunningham does not disclose a subsea lubricator. Thus, by definition, it does not disclose the various method steps recited in claim 50 in connection with the subsea lubricator set forth in the amended claim. Accordingly, for at least this reason, claim 50 is allowable over the art of record.

Moreover, claim 50 recites the acts of connecting a first supply pipe to the first passage, connecting a second supply pipe to the lower bypass passage and circulating fluid from the second supply pipe, through the lower bypass pipe, through the annulus passage, down into the

well through the tubing annulus, through the downhole fluid connection, up through the tubing string, through the production passage, through the first passage in the pressure control assembly, and into the first supply pipe. Respectfully, Cunningham simply does not disclose the performance of these method steps.

In rejecting claim 50, the Examiner again cites to the same passage in Cunningham – Col. 6, ll. 22-25. Final Office Action, p. 8. As discussed above, the Examiner identified passage in Cunningham is directed to the situation where “circulation fluid, such as sea water, is then pumped down tubing 50 and is directed back up the annulus between the bore 48 and the tubing 50 by blind ram 80 to thereby clear membrane riser 18 of production fluid.” Col. 6, ll. 22-25 (emphasis added). Simply put, in Cunningham, the circulation fluid is pumped down coiled tubing 50 and up the annulus between the bore 48 and the coil tubing 50 and thus back to the surface. Cunningham does not disclose or suggest that this circulating fluid or the original production fluid in the riser 18 is circulated to the well at all. Moreover, in the method identified by the Examiner in Cunningham, the bypass line 82 disclosed therein is not employed at all.

As understood by the undersigned, Cunningham does disclose a situation where a fluid is circulated between the surface vessel 12 and the well. Col. 6, ll. 44-59. However, the methodology described in that passage is very different from that set forth in claim 50. More specifically, in that situation, the annulus isolation valve 76 and the blind ram 80 are closed, and the tubing 50 is inserted until it contacts the closed blind ram 80. Thereafter, the grip and seal tubing ram 78 is closed around the tubing 50. The crossover valve 74 and the production bypass valve 84 are opened. A flow path is thus established down the tubing 50, through the crossover

conduit 72, down the production bypass loop 82 and back to the surface vessel 12 through the annulus between the bore 48 and the tubing 50. The path may be reversed if desired.

In rejecting claim 50, the Examiner identified the line 32 as the “second supply pipe” and the portion of the bypass line 82 (below production bypass valve 84) as the “lower bypass passage.” Final Office Action, p. 8. In fact, Cunningham states that the line 32 is a control umbilical, not a supply pipe. Col. 5, ll. 1-19. Moreover, at no point does Cunningham suggest that the control umbilical 32 is employed in circulating fluids into the well or that the control umbilical is even connected to the lower portion of the bypass line 82. Thus, it is respectfully submitted that Cunningham is far afield from the method set forth in claim 50.

4. Claim 51

Claim 51 requires, among other things, connecting a first supply pipe to the first passage, connecting a second supply pipe to the lower bypass pipe and circulating fluid from the first supply pipe, through the first passage in the pressure control assembly, through the production passage, down into the well through the tubing string, through the downhole fluid connection, up through the tubing annulus, through the annulus passage, through the lower bypass pipe and into the second supply pipe.

In rejecting claim 51, the Examiner employed the same rationale and logic employed in rejecting claim 50. As set forth above, the umbilical 32 in Cunningham – identified by the Examiner as the “second supply pipe” – is simply not a supply pipe at all. Moreover, Cunningham does not disclose or suggest using the umbilical line 32 in circulating fluids to or from the well, nor does it disclose connecting the umbilical 32 to the lower portion of the bypass

line 82 (identified by the Examiner as the “lower bypass line”). Thus, for at least these reasons, claim 51 is allowable over the art of record.

For at least the aforementioned reasons, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON
CUSTOMER NO. 23720

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/J. Mike Amerson/

J. Mike Amerson
Reg. No. 35,426
10333 Richmond, Suite 1100
Houston, Texas 77042
(713) 934-4055
(713) 934-7011 (facsimile)

ATTORNEY FOR APPLICANT